

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-5, 9-15 and 18 are rejected under 35 USC 102(b) over the U.S. patent to Shimada.

Claims 6-8, 16 and 17 are rejected under 35 USC 103(a) over the patent to Shimada in view of the U.S. patent to Lauer.

Also, the claims were rejected under 35 USC 112.

In connection with the Examiner's rejection over the art and formal rejections under 35 USC 112, applicant amended Claims 1 and 11, and the broadest independent claims.

It is respectfully submitted that these claims clearly and patentably the present invention from the prior art and clarified the issues raised by the Examiner in his formal rejection of the claims.

Claim 1 has been amended to define that the winding template (29) and the adjacent deflection element (31) are rotatable about the pivot axis (36). This feature is clearly shown in Figure 1, where it is clear that the winding

template (29) and the deflection element (31) are rotatable about the pivot axis (36). Moreover, this feature can be derived from the original Claim 3, since it is stated that the carrier device (23) is rotatable about a pivot axis (36). Since the carrier device (23) is secured at least to one winding template (29) and also at least to one deflecting element (31), it is to be understood that at least one winding template (29) as well as at least one deflecting element (31) are rotatable about the rotary axis (36).

Claim 1 has been further amended to define that the carrier device (23) with the winding template (29) and the adjacent deflection element (31) are displaceable transversely to the pivot axis (36). This feature also can be seen in Figure 1 in which the double arrow related to the carrier device (23) identifies the displacement of the carrier device (23) transversely to the pivot axis (36). It is also disclosed in the second paragraph on page 7 of the specification, in which it is stated that the pivot axis (36) is displaceable relative to the carrier device (23). It is then also stated there that in this concrete exemplary embodiment the carrier device (23) is displaceable in the holder (26) so that the fixed pivot axis (36) is displaced relative to the carrier device.

Claim 11 has been amended to define that the winding template (29) and the adjacent deflection element (31) are secured to the carrier device (23). It is further now defined in Claim 11 that at least one coil is wound about the winding template in a first direction of rotation, while the carrier device (23) is

rotated about a pivot axis (36). Finally, it is stated that the winding template (29) is displaced out of a plane for free winding, and then in a further step the coil is wound in a second direction of rotation which is opposite to the first direction of rotation. This is disclosed in the specification, for example in the beginning of second paragraph on page 11.

Turning now to the reference and in particular the patent to Shimada, it can be mentioned that the distinctive feature of the present invention as defined in Claim 1 is that the winding template (29) and the deflection element (31) are rotatable about the pivot axis (36). In Claim 11 it is defined that this axis is the axis, around which the carrier device (23) is rotatable. The winding template (29) and the deflecting element (31) are also rotatable about the pivot axis (36). As mentioned before, in the Office Action the core (16) is identified as the winding template. This core however is not rotatable. Furthermore, the deflecting elements (24, 25) are not rotatable about the pivot axis defined by the shaft (28).

The next new feature that the carrier device (23) with the winding template (29) and the deflecting element (31) are displaceable transversely to the pivot axis of the carrier device (23) is also not disclosed in the patent to Shimada. The carrier device identified in the Office Action is composed of the parts (27, 28) and rotates exclusively around the shaft (28). The carrier device is not displaceable and in particular not displaceable transversely to the pivot axis of

the carrier device. Moreover, the winding template (core 16) and the deflecting elements (24, 25) are not displaceable transversely to the pivot axis of the carrier device.

It is believed to be clear that the new features of the present invention as now defined in Claim 1 are not disclosed in this reference. Also, the reference does not contain any hint or suggestion for such features.

Claim 11 also defines the new features which are not disclosed in the patent to Shimada. The feature that a coil is wound around the winding template (29) in a first rotary direction, wherein the carrier device (23) is rotated around an axis (36) and in a further step around the deflecting element (31) a first coil connector (30) is wound, so that the coil is wound in a second rotary direction which is opposite of the first rotary direction, is also not disclosed in the patent to Shimada. In the reference the coil (33) is wound exclusively in one rotary direction around the core (16) as explained in the reference in column 3, lines 40-43. The other references also do not teach the features of Claim 11.

The original claims were rejected over the patent to Shimada as being anticipated. In connection with this it is believed to be advisable to cite the decision *In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Shimada does not disclose each and every element of the present invention as defined in Claims 1 and 11.

It is therefore respectfully submitted that the anticipation rejection of the original claims should be considered as not tenable with respect to amended Claims 1 and 11 and should be withdrawn.

As for the rejection over the combination of the references, namely the patents to Shimada and Lauer applied by the Examiner, it is respectfully submitted that none of these references provide any hint or suggestion or motivation for the new features of the present invention as defined in Claims 1 and 11. In order to arrive at the applicant's invention from the teachings of these references taken singly or in combination with one another, the references have to be fundamentally modified by including into them the new features of the present invention which are now defined in amended Claims 1 and 11. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments it is respectfully submitted that Claims 1 and 11 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the corresponding independent claims, they share their allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should

the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long, sweeping horizontal line extending to the right.

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